Remarks/Arguments:

I.   Status

The Office Action dated September 22, 2004 (the "Office Action") has been carefully reviewed. Claims 1-13 have been canceled. Claims 14-16 and 18-20 have been amended and claims 21-27 have been added. Accordingly, claims 14-27 are pending in this application. Reconsideration of this application, as amended, is respectfully requested.

II.   35 U.S.C. § 101 Rejection.

Claims 14-20 were rejected in the Office Action for being directed to non-statutory subject matter. (Office Action at page 3).

Claims 14-20 have been amended to clarify that the method steps recited are directed to statutory subject matter. Accordingly, the Applicants respectfully submit that the rejection of claims 14-20 has been overcome. Therefore, the Applicants respectfully submit that the rejection of claims 14-20 under 35 U.S.C. § 101 should be withdrawn.

II.   35 U.S.C. § 112 Rejection.

Claims 14-20 were rejected in the Office Action for being indefinite. (Office Action at page 3).

Claims 14-20 have been amended to clarify the method being claimed. Additionally, claims 14 and 18 have been amended to more clearly identify the antecedent basis of "second client computer". Accordingly, the Applicants respectfully

submit that the rejection of claims 14-20 has been overcome. Therefore, the Applicants respectfully submit that the rejection of claims 14-20 under 35 U.S.C. § 112 should be withdrawn.

III.   Duplicative Claims

The Examiner warned that claims 18 and 19 were substantially duplicative of claims 14 and 15, and claim 20 was provisionally objected to for being a substantial duplication of claim 16. Claims 19 and 20 depend from claim 18. Claim 18 has been amended to include limitations not present in claims 14, 15 or 16. Accordingly, it is respectfully submitted that the Examiner's warning regarding claims 18-19 and the provisional objection to claim 20 has been overcome. Therefore, the Applicants respectfully submit that the claims 18-20 are in condition for allowance.

IV.   The Rejection of Claims 14, 15 and 17 under 102(e) Should be Withdrawn.

In the Office Action, claims 14, 15 and 17 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2003/0061566 A1 to Rubstein et al. (hereinafter "Rubstein"). The Applicants respectfully traverse.

The Definition of "e-mail"

The Examiner has offered a definition for the term "e-mail" that was allegedly obtained from a *Microsoft Press Computer Dictionary*. (Office Action at page 5). Respectfully, the proposed definition is not reasonable.

Specifically, the Examiner proposes that "e-mail" be defined as "the exchange of text messages and computer files over a communications network". (Id. at page 5). While "e-mail" admittedly is included within such a definition, the definition would, at least arguably, encompass any data transfer over a network. As an example, even sending a file to a printer for printout would be considered "e-mail" under such a broad definition. Accordingly, the proposed definition is unreasonable.

The Applicant has submitted herewith an IDS including three sources that define and/or discuss the term "e-mail". All three sources (including the definition available in the *Microsoft Press Computer Dictionary*) are substantially more restricted than the mere exchange of text messages and computer files over a network. Specifically, a rather basic concept of "e-mail" is that the text message or computer file is directed to an electronic mailbox. At some point thereafter, the recipient accesses the electronic mailbox and retrieves the text message or computer file. (See e.g. *Microsoft Press Computer Dictionary* (1991) at page 125, "[d]elivered messages are stored in electronic mailboxes assigned to users on the network and can be viewed, saved or deleted by the recipient.").

Accordingly, to the extent the Examiner requires a definition of the commonly understood term "e-mail", the Applicant respectfully submits that the definition should include that the text message or computer file is directed to an electronic mailbox for later retrieval by the recipient.

The Present Invention

The present invention relates to a system and method whereby an advertisement is appended to an e-mail that has been sent by an e-mail user to another e-mail user. In

accordance with one non-limiting embodiment, an e-mail user at a first client computer sends an e-mail to a user at a second client computer. The e-mail is routed to the second client computer through a host server. The host server appends an advertisement to the e-mail and passes the e-mail to the second client computer. When the user at the second client computer accesses the e-mail, the advertisement is displayed.

In a further embodiment, an advertisement retrieval software means is appended to the-mail at the host server in place of the above described advertisement. Thus, when the user at the second client computer accesses the e-mail, the advertisement retrieval software means retrieves an advertisement stored at the host server and the retrieved advertisement is displayed to the user at the second client computer.

In a further embodiment, the user at the first client computer designates an entity, which may be a charitable organization. Accordingly, when the advertisement is displayed at the second client computer, a contribution is made to the designated entity.

Thus, the present invention relates to the appending of an advertisement or advertisement retrieval means to an e-mail.

Rubstein

Rubstein discloses a process for dynamically integrating two or more digital files. (Rubstein at Abstract). In accordance with Rubstein, a user logs into a website using a first client computer and selects a card for purchase. (Id. at paragraph 37). The user makes modifications (selecting design, message segment and media content) to the card file 46 and provides information such as payment method. (Id. at paragraph 37). The user then downloads the card file 46 to the purchaser's computer. (Id. at paragraph 37).

Alternatively, the card file 46 may be e-mailed to the purchaser. (Id. at paragraph 37)

Prior to delivery of the card file 46, the system of Rubstein dynamically integrates an

advertisement 54 into the card file 46. (Id. at paragraph 39, FIG. 3). After the card file

46 is downloaded to the first client computer, the purchaser further personalizes the card.

(Id. at paragraph 38). Subsequently, the card file 46, which already includes the

advertisement 54, is e-mailed from the first client computer to a second client computer.

(Id. at paragraph 38).

Therefore, in accordance with the above described process, the advertisement is

appended to the card file and the card file is then downloaded or e-mailed to the *first*

client computer. However, this embodiment does not disclose an advertisement being

appended to an e-mail after the e-mail is sent from the first client computer, wherein the

e-mail is passed via a host computer to a second client computer.

Rubstein discloses a second process for the personalization of the card file 46. In

accordance with the second process, the card file 46 is not downloaded to the first client

computer. Rather, the purchaser customizes the card file at the vendor's server. (Id. at

paragraph 41). After the card has been personalized, "the card is sent to the recipient

from the server as an attachment to an e-mail." (Id. at paragraph 41). Alternatively, a

link is sent to the recipient who can download the card file by invoking the link. (Id. at

paragraph 41). Therefore, according to the second process of Rubstein, the only e-mail

that is sent is sent from the host to the recipient computer.

Thus, Rubstein does not disclose appending e-mails with advertisements. Rather,

Rubstein discloses sending file cards appended with advertisements via e-mail.

Discussion Regarding Patentability of Claim 14

1. <u>Claim 14</u>

Claim 14, as amended, recites:

> A method for generating revenue using electronic mail, comprising the steps of:
> transmitting an e-mail message from a first client computer to a host server through at least one computer network, wherein the e-mail message comprises an e-mail address of an e-mail user, an e-mail address of at least one e-mail recipient, a subject, and a body;
> appending advertisement retrieval software means to the e-mail message, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database;
> transmitting the e-mail message from the host server to a second client computer through the at least one computer network; and
> displaying the e-mail message on the second client computer, wherein when the e-mail message is first displayed on the second client computer the advertisement software retrieval means is operable at the second client computer to retrieve at least one of the advertisements retrievably stored in the database for display with the e-mail message on the second client computer.

Claim 14 thus recites a method wherein an e-mail message is transmitted from a first client computer through an intermediate computer to a second client computer. The e-mail message is recited as including the limitations of an e-mail address of an e-mail user and an e-mail address of at least one e-mail recipient.

2. <u>Rubstein Does Not Disclose Transmitting an E-mail Through An Intermediate Computer</u>

The Examiner alleged that Rubstein discloses transmitting an e-mail from a first client computer through a host server to a recipient. (Office Action at page 5). Respectfully, the Examiner has mischaracterized Rubstein.

Specifically, the Examiner alleges that the communication used to order, personalize and send the personalized greeting card as disclosed by Rubstein is a single e-mail message, citing to Rubstein at paragraph 41. However, in paragraph 41, Rubstein discloses that a customer customizes a card file at the vendor's server. (Rubstein at

paragraph 41). There is no mention whatsoever that the customization is effected by transmission of an e-mail message from the customer to the vendor's server wherein the e-mail message includes an e-mail address of an e-mail user and an e-mail address of at least one e-mail recipient. Furthermore, there is no suggestion that any of the data provided by the customer to the vendor's server is sent to an electronic mailbox for later access by the vendor's server.

Moreover, the Examiner's reliance on the use of the term "post office function" to show that the entire communication between the user and the server and the subsequent delivery of a card to a recipient is "one e-mail" is misplaced. Rubstein states that "[t]he server provides a post office function as it can send the personalized card file directly to the recipient designated by the purchaser." (Id. at paragraph 41). Rubstein thus identifies the sending of a card *from the server to the recipient* as the "post office function". Accordingly, Rubstein expressly refutes the Examiner's proposition that the entire communication used by a purchaser to purchase a card plus the subsequent delivery of the card is one e-mail. Rather, accepting the Examiner's reliance on the disclosed "post office function" as identifying a single e-mail, the single e-mail is *only the message from the server to the recipient*. Therefore, the single e-mail message identified by Rubstein is transmitted from a host server directly to a client computer.

Finally, even if the customer's access of the vendor's website is an e-mail, the advertisement of Rubstein is not appended to the e-mail that is sent from the customer to the vendor's website. Rather, the advertisement is appended to the card file 46 which is subsequently sent directly to the recipient from the host server.

Rubstein does not disclose customization of a card file at a host server using an e-mail message including an e-mail address of an e-mail user and an e-mail address of at least one e-mail recipient. Moreover, the e-mail of Rubstein relied upon by the Examiner is not transmitted from a first client computer through an intermediate computer to a second client computer. Therefore, the Examiner has failed to identify any disclosure or even a suggestion in Rubstein of an e-mail including an e-mail address of an e-mail user and an e-mail address of at least one e-mail recipient that is transmitted from a first client computer through an intermediate computer to a second client computer as recited in claim 14. Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Accordingly, because claim 14 recites a method of transmitting an e-mail through an intermediate host server and Rubstein does not disclose any such method, the Applicants submit that the rejection of claim 14 has been successfully traversed.

Discussion Regarding Patentability of Claims 15 and 17

The Examiner has rejected claims 15 and 17 based upon the same prior art discussed above with respect to claim 14. Claims 15 and 17 depend from claim 14 and include the same limitations discussed above with respect to claim 14. Therefore, for at least the same reasons set forth above with respect to claim 14, claims 15 an 17 are allowable over the prior art.

V.   The Rejection of Claims 18 and 19 under 103(a) Should be Withdrawn.

In the Office Action, claims 18 and 19 were rejected under 35 U.S.C. 103(a) as

being obvious over Rubstein. The Applicants respectfully traverse.

Discussion Regarding Patentability of Claim 18

1.   Claim 18

Claim 18, as amended recites:

> A method for sending e-mail messages appended with advertising, comprising the steps
of:
> storing an identifier for an entity selected by an e-mail user;
> transmitting an e-mail message from a first client computer to a host server through at least one
computer network, wherein the e-mail message comprises an e-mail address of the e-mail user, an e-mail
address of at least one e-mail recipient, a subject, and a body;
> appending advertisement retrieval software means to the e-mail message, wherein the
advertisement retrieval software means comprises information about at least one of a plurality of
advertisements retrievably stored in a database;
> transmitting the e-mail message from the host server to a second client computer through the at
least one computer network;
> displaying the e-mail message on the second client computer;
> retrieving at least one of the plurality of advertisements retrievably stored in the database for
display with the e-mail message on the second client computer; and
> accounting for a contribution to the entity identified by the stored identifier.

Claim 18 thus recites a method wherein an e-mail message is transmitted from a

first client computer through an intermediate computer to a second client computer. The

e-mail message is recited as including the limitations of an e-mail address of an e-mail

user and an e-mail address of at least one e-mail recipient.   Claim 18 further recites a

step of accounting for a contribution to an entity identified by a user.

2.   Rubstein Does Not Disclose the Claimed Accounting

As amended, claim 18 includes the step of accounting for a contribution to an

entity identified by an e-mail user. Although Rubstein discusses *charging a fee* to

advertisers, Applicant is not aware of any teaching or suggestion in Rubstein of an accounting for a *contribution to* an entity identified by the e-mail user. Therefore, it is respectfully submitted that claim 18 as amended is patentable over the cited prior art.

3.   The Discussion of Claim 14 Applies to Claim 18

The Examiner rejected claim 18 based primarily upon Rubstein, further alleging that inclusion of information related to the preferred charitable organization of the e-mail user was obvious. Claim 18 recites a method wherein an e-mail message with the-mail address of the e-mail user and the e-mail address of the e-mail recipient is transmitted from a first client computer through an intermediate computer to a second client computer. This recitation is similar to the recitation discussed above with respect to claim 14. Accordingly, even if Rubstein is modified to include information about an e-mail user's preferred charitable organization, the modification does not arrive at the invention of claim 18. Therefore, under MPEP § 2143.03, the Examiner has failed to present a *prima facie* case of obviousness and the rejection of claim 18 under 35 U.S.C. 103(a) should be withdrawn.

4.   There is no Motivation for the Proposed Modification

The Examiner has stated that because 1) charitable giving is related to income and stock ownership and because 2) income and stock ownership reads on receiving proceeds, that it would be obvious to make the proposed modification. (Office Action at page 6). However, the Examiner has failed to allege why, even assuming such

allegations are true, one of ordinary skill in the art would *want* to make the proposed modification.

Accordingly, even if the two factual allegations made by the Examiner are true, a motivation for the proposed modification has not been alleged. Therefore, under MPEP § 2143.03, the Examiner has failed to present a *prima facie* case of obviousness and the rejection of claim 18 under 35 U.S.C. 103(a) should be withdrawn.

5. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the rejection of claim 18 as being obvious over Rubstein has been overcome and/or successfully traversed, and the Applicants respectfully submit that the rejection of claim 18 under 35 U.S.C. § 103 should be withdrawn.

Discussion Regarding Patentability of Claim 19

The Examiner has rejected claim 19 based upon the same modification of Rubstein and the same arguments discussed above with respect to claim 18. Claim 19 depends from claim 18 and includes all of the limitations of claim 18 as amended. Therefore, for at least the same reasons set forth above with respect to claim 18, claim 19 is allowable over the prior art.

VI. **Claims 21-27.**

Claims 21-27 have been added. These claims recite novel and non-obvious limitations. Accordingly, claims 21-27 are believed to be allowable over the prior art.

VII. Conclusion

Applicants respectfully request entry of the amendments and favorable

consideration of the application.

A prompt and favorable action on the merits is requested.

Respectfully Submitted,
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